

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI INOUE

Appeal 2007-1525
Application 10/664,628
Technology Center 1700

Decided: September 7, 2007

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's
decision rejecting claims 1, 3, 5, and 7. We have jurisdiction under
35 U.S.C. § 6.

We AFFIRM.

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Appellant claims a wet paper web transfer belt which comprises a wet paper web side layer 11 having an elastic section 50 with fibers 20 protruding from the web-contacting surface of the elastic section, wherein the average length of the protruding parts of the fibers is between 0.01 and 3 mm (Claim 1; Fig. 5).

Representative claim 1 reads as follows:

1. A wet paper web transfer belt for use in the press part of a closed draw papermaking machine, comprising a base body, a wet paper web side layer having an elastic section, said elastic section having a wet paper web-contacting surface, and a machine side layer, said belt having fibers, parts of which are embedded in said elastic section, and parts of which protrude from said web-contacting surface, wherein the average length of the protruding parts of said fibers is between 0.01 and 3 mm.

The references set forth below are relied upon by the Examiner as evidence of obviousness:¹

| | | |
|----------------------------|-----------------|---------------|
| Lundström (Lundström '588) | US 4,500,588 | Feb. 19, 1985 |
| Lundström (Lundström '643) | US 4,529,643 | Jul. 16, 1985 |
| Valentine | US 5,849,395 | Dec. 15, 1998 |
| Gstrein | US 6,383,339 B1 | May 7, 2002 |
| Hagfors | US 6,605,188 B2 | Aug. 12, 2003 |

¹ In the “Response to Argument” section of the Answer, the Examiner refers to the Eklund Patent 5,298,124 of record as further supporting a conclusion of obviousness (Answer 9). Because this patent is not included in the Examiner’s statement of rejection, the Examiner should not have referred to Eklund as supporting an obviousness conclusion. *See In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). *See also* The Manual of Patent Examining Procedure (MPEP) § 706.02(j) (8th ed., Rev. 5, Aug. 2006). Therefore, we have not considered the Eklund patent in assessing the merits of the Examiner’s § 103 rejection.

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Claims 1 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gstrein in view of Hagfors and further in view of either Lundström '588 or Lundström '643 or alternatively over Hagsfors in view of Lundström '588 or Lundström '643; and claims 3 and 7 are correspondingly rejected over the aforementioned references and further in view of Valentine.

The sole issue raised by this appeal is described by Appellant as follows:

No separate argument is being made for the dependent claims. All of the rejections depend on Hagfors, and the dispositive issue in this case is whether or not Hagfors teaches that the average length of the protruding parts of fibers protruding from the web-contacting surface of an elastic section should be between 0.01 and 3 mm.

(Appeal Br. 9).

Concerning this issue, the Examiner correctly finds that Hagfors discloses grinding the surface of a fiber-containing polymer matrix to thereby obtain a surface with fibers thereon having a certain micro-roughness (Hagfors, col. 1, l. 57 - col. 2, l. 10) (Answer 7).

Appellant uses a corresponding technique of grinding the surface of a fiber-containing elastic section to thereby obtain protruding fibers having an average length within the here-claimed range (Specification 8, ¶ [0040] and 12, ¶ [0054]).

The Examiner also correctly finds that Hagfors discloses an average surface roughness (Ra) of between 1 to 30 μm (i.e., 0.001 to 0.03 mm) (Hagfors, col. 4, ll. 25-27) (Answer 7).

The Examiner believes that Hagfors' above-disclosed range of roughness values supports his belief that the protruding fibers of Patentee's transfer belt would possess an average length range which overlaps Appellant's claim 1 range (Answer 8).

In response, Appellant states that, if a random distribution of fiber angles is assumed, the exposed lengths of Hagfors' fibers would be in the range from approximately 0.006 mm to approximately 0.017 mm and concedes that this range overlaps the claim 1 range of 0.01 to 3.0 mm (Reply Br. 2). According to Appellant, however, FIG. 1 of Hagfors shows that the fiber angles do not have a uniform distribution but instead are all disposed nearly parallel to the surface of the belt (Br. 2-3). These circumstances lead Appellant to conclude that the average length of Hagfors' exposed fibers is outside the claim 1 range (Reply Br. 4).

Appellant's interpretation of Hagfors is not well taken. For a number of reasons, we consider the fiber disposition shown as parallel to the belt surface in Patentee's FIG. 1 to be a matter of draftman's convenience rather than an accurate showing of the fiber disposition. First, nowhere does Hagfors' Specification describe the fiber disposition as parallel to the belt surface. Second, this Specification nowhere teaches any technique for achieving this parallel disposition. Third, Hagfors expressly teaches that the

fibers in his polymer matrix can be mixed together in a suitable manner whereby a suitable distribution of different fibers is produced (Hagfors, col. 2, ll. 41-45; col. 4, claim 3). In light of this teaching, it is reasonable to believe that Hagfors' fiber angles are randomly distributed which Appellant concedes would yield a range of exposed fiber lengths overlapping the claim 1 range (Reply Br. 2).

For the above stated reasons, there is ample basis in fact which reasonably supports the Examiner's determination that the average length of protruding fibers between 0.01 and 3 mm as required by claim 1 necessarily flows from the teachings of Hagfors. *See Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990). This basis in fact includes: (1) the fact that the claim 1 range and Hagfors' desired range of roughness values are both produced from corresponding materials (i.e., fiber-containing polymer) and techniques (i.e., grinding of the polymer surface to thereby expose the fibers contained therein); and (2) the fact that Hagfors' col. 2 teaching of mixing fibers would yield a random distribution which Appellant concedes would produce a range of fiber lengths which overlaps the claim 1 range (Reply Br. 2).

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the Patent and Trademark Office can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under

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35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). *See also In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82-83 (CCPA 1975).

Because the transfer belt products defined by claim 1 and disclosed by Hagfors appear to be identical and appear to be manufactured by identical processes, it is appropriate to require Appellant to prove that Hagfors' transfer belt does not necessarily and inherently contain the average length range of claim 1. On this record, the Appellant has proffered no such proof. Therefore, we sustain each of the § 103 rejections advanced by the Examiner on this appeal.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

clj

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